

Additionally, in response to the Election of Species requirement related to the claims of Group I, Applicants hereby elect the following species for initial examination:

Dimer: iosmin, which is referenced in paragraph [0039] and illustrated by the structure at the top of page 5 of Applicants' published application – US 2008/0317675 – and furthermore is recited in claim 16 (wherein  $A_2$  and  $A_3$  are  $\text{CONH}_2$ ,  $D_2$  and  $B_3$  are  $\text{CON(R)}R_1$ , with  $R = \text{H}$  and  $R_1 = \text{CH}_2\text{CH(OH)CH}_2\text{(OH)}$ ,  $E_2$  and  $E_3$  are  $\text{N(R)C(O)}$ , with  $R = \text{CH}_2\text{CH(OH)CH}_2\text{(OH)}$ , and  $X = \text{CH}_2$ ); and,

Monomer: ioversol, which is referenced in paragraph [0032] and illustrated by the structure near the bottom of page 3 of Applicants' published application – US 2008/0317675 – and furthermore is recited in claim 18 (wherein  $A_1$  and  $B_1$  are  $\text{CON(R}_3\text{)R}_1$ , with  $R_1 = \text{H}$  and  $R_3 = \text{CH}_2\text{CH(OH)CH}_2\text{(OH)}$ , and  $D_1$  is  $\text{N(R)C(O)R}_2$ , with  $R_2 = \text{CH}_2\text{(OH)}$  and  $R = \text{CH}_2\text{CH}_2\text{(OH)}$ ).

Applicants note that, upon allowance of a generic claim, they will be entitled to consideration of claims to additional species that are written in dependent form, or otherwise include all the limitations of an allowed generic claim (as provided by 37 CFR 1.141). Currently, elected claim 1 is generic. Additionally, elected claims reading on the noted species include claims 2-7, 10, 11, and 13-20.

As noted above, Applicants respectfully **traverse** the present Restriction Requirement. Applicants note that the Office supports its requirement for restriction based on lack of a single inventive concept under PCT Rule 13.1 because, under Rule 13.2, Groups I-III are said to lack a common technical feature. In particular, the Office suggests that US 5,695,742 discloses the compounds of Group I, which provides the common technical feature between Groups I-III.

Applicants respectfully disagree with the Office's characterization of US 5,695,742. Specifically, Applicants submit that US 5,695,742 fails to disclose each and every element of claim 1. Claim 1, from which claims 2-26 directly or indirectly depend, calls for, in relevant part, a triiodo-substituted dimer that contains **at least one primary amide** (note the proviso which states that at least one of  $A_2$  and  $A_3$  is  $-\text{CONH}_2$ ). In contrast, nowhere does US 5,695,742 disclose a triiodo-substituted dimer that contains at least one primary amide. As a result, Applicants submit that this limitation clearly imparts a common technical feature, or a single

inventive concept, to the claims of Groups I-III. Applicants further submit that claim 1, as well as all claims depending therefrom, are novel in view of US 5,695,742.<sup>1</sup>

In view of the fact that the Office has offered no other reason as to why the claims of Groups I-III lack Unity of Invention, or otherwise require restriction, Applicants respectfully request that the present restriction be withdrawn and that all claims be examined at this time. If, however, the Office disagrees, Applicants submit that at least the claims of Groups I and II should be rejoined for examination at this time, particularly given that there is essentially no additional burden placed on the Office to examine the claims of Group II.

The Commissioner is hereby authorized to charge Deposit Account No. 13-1160 for any fees that may be required for this Response to Restriction Requirement in the name of Mallinckrodt Inc., including the fee associated with a one (1) month extension of time.

Respectfully submitted,

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VIA EFS

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<sup>1</sup> In this regard it is to be noted that, inasmuch as the Office has not formally rejected claim 1, or any claim depending therefrom, for lack of novelty, a full explanation of the novelty of claim 1 over the cited patent has not been provided at this time. However, Applicants respectfully reserve the right to present new and/or additional arguments relating to the novelty of the claimed subject matter over the cited patent at a later date, should such arguments be necessary.